

REMARKS

Claims 1-57 are pending. Applicant has amended Claims 26, 32, 37, 38, 40, 41, and 43, added new Claims 44-57, and canceled Claim 39 without prejudice. No new matter has been added, and all of the pending claims are believed to be in a condition for allowance.

I. The Declaration

The Examiner noted that the Declaration was defective, as it referenced an incorrect serial number. Applicant submits herewith a replacement Declaration, which corrects the Examiner's noted error.

II. Claim Rejection Under 35 U.S.C. § 112

The Examiner rejected Claims 26 and 32-38 pursuant to 35 U.S.C. § 112 as being indefinite for failing to point out and distinctly claim the subject matter that applicant regards as the invention.

For Claim 32, the Examiner determined that the claim is indefinite because "it is unclear how the strip by itself would function to mold a lens." The Examiner further suggested that the limitations of Claim 39 be included in Claim 32 to perform the recited functionality. Applicant has made this suggested amendment and cast the limitations of Claim 39 in Claim 32 to state that the body of the strip is "adapted to" perform that functionality of forming a molding cavity, which thus enables the strip to be used for molding a lens. To that end, amended Claim 32 now reads:

A strip for molding a lens, comprising:

- a. a body having a first end and a second end, and an inner surface and an opposed outer surface, wherein the body of the strip is *adapted to* be wrapped around edges of a front mold and a back mold to form a sleeve

- cooperating with the front mold and the back mold to define a molding cavity; and
- b. a recess channel formed on the inner surface. (Emphasis added.)

As Claim 32 is cast, applicant respectfully submits that the molds themselves are not limitations, but the claimed body must have the functionality related to the molds.

One relevant legal decision standing for this proposition is *In re Dean*, 291 F.2d 947, 130 U.S.P.Q. 107 (1961). There, the Court of Customs and Patent Appeals—the predecessor to the Federal Circuit—interpreted a claim that set forth the following limitations:

In a camera having a shutter mechanism including two independently operable shutter-actuating elements, a shutter-timing apparatus for effecting a precisely predetermined camera exposure comprising:

- (1) a pair of electro-responsive devices *adapted to be individually coupled to said elements*;
- (2) an alternating-current supply circuit;
- * * * *
- (7) an electrical time-constant circuit responsive to operation of said pulse-developing means.... (Emphasis added.)

The court interpreted the phrase “adapted to be individually coupled to said [shutter-actuating] elements” as follows:

To state mere adaptability of these parts of the timer to perform the coupling function does not import into the claim the shutter to which they are coupled. The above clause is a limitation of element (1) but not an inclusion of shutter elements.

Id. at 951. Based on this legal authority, applicant believes that this amendment fully addresses and overcomes the Examiner’s rejection of Claims 32-38 under 35 U.S.C.

§ 112.

The Examiner also rejected Claims 26 and 37 because “the trademark ‘KRATON G’ should be replaced with generic terminology.” Applicant has amended the claims accordingly to remove this trademark. For Claim 26, applicant has included thermoplastic rubbers containing a styrene-ethylene-propylene (butylene) block

copolymer, support for which can be found, *inter alia*, in Claim 37 as originally filed. Applicant believes that these amendments overcome the Examiner's rejection, but are not narrowing from the claims as originally filed.

Also, although not subject to a rejection or objection, applicant amended Claim 38 to read "8.0 millimeters" instead of "8.0 millimeter," which was a typographical error. Applicant also amended Claim 40 to read "a bore extending from the first end *to* the second end" instead of "a bore extending from the first end *and* the second end" for clarity. Similarly, applicant modified Claim 41 to read that the "recess channel extends continuously from the venting port *to* the casting port" instead of extending "from the venting port *and* the casting port." The amendments addressed in this paragraph are not narrowing in nature, but are made solely to improve clarity.

Applicant, accordingly, respectfully requests that the Examiner withdraw the rejection of Claims 26 and 32-38 under 35 U.S.C. § 112 and allow the amendments discussed above.

III. Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected Claims 40-42 pursuant to 35 U.S.C. § 102 as being anticipated by Orlosky, U.S. Patent No. 4,693,446. Applicant respectfully traverses the rejection of these claims.

Orlosky cannot render independent Claim 40 or its respective dependent claims unpatentable based on the claimed venting port being different from the structure disclosed in the Orlosky patent. Orlosky teaches that its gasket is to be filled while oriented horizontally. To that end, the Orlosky disclosure notes:

By introducing the resin at a relatively slow rate, *while maintaining the lens casting cavity in a horizontal position*, it has been found that the resin completely fills the cavity. The apparent reason for this is that the resin is relatively viscous. As the resin enters the casting cavity it sticks together and completely fills the cavity as it moves from one side to the other. As the lens casting cavity is filling, the air in the cavity is pushed out through the vent hole.

An additional advantage is found in that even if the mold halves are opaque, *a user can determine when the lens casting cavity is filled by merely monitoring the opening used as a vent hole to see when the resin has begun to fill it. As soon as resin is seen filling the vent hole, the user knows that the casting cavity is full.* This filling system, whereby the lens cavity is filled from side-to-side while the gasket is kept in a horizontal position, allows for much faster and bubble-free filling than was previously possible in the art.

Orlosky, col. 7, lines 21-40 emphasis added).

As one skilled in the art appreciates, if the vent hole extends between the interior surface and the exterior surface of the gasket, then the monomer will begin to leak out when it reaches the vent hole and before the molding cavity is completely filled. Thus, a necessary design feature of Orlosky is that at least a portion of the vent opening extends upwardly to communicate with ambient at a height equal to or above the highest point in its mold cavity. *See Figure 3.* That is, since the Orlosky vent hole does not extend between the interior and exterior surfaces of the gasket, the resin or monomer filling the mold cavity must overcome the force of gravity and also frictional resistance to exit from the elevated outlet of the vent hole—requiring that the mold cavity be substantially filled for there to be sufficient energy to overcome these resistive forces.

The invention set forth in Claim 40, in contrast, does not use the Orlosky vent hole design and, to distinguish this claimed invention more clearly, Claim 40 now reads, in part that:

a venting port formed through the body portion to interconnect the inner portion and the outer portion.

Support for this amendment can be found, *inter alia*, in Figures 3-6, 10, 12, and 13 (*i.e.*, reference numerals “18,” “62,” “1222,” or “1328”) of the present application.

The venting port claimed is a different design from the vent hole of Orlosky designated as “54” or “56,” which is both horizontally and vertically oriented so that the vent hole does not extend “to interconnect” the interior and exterior portions of the Orlosky gasket, as Claim 40 sets forth.

Based on these differences, Orlosky cannot anticipate the claims at issue. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference.”) (quoting *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983)) (emphasis in original).

Nor does the cited reference render obvious the claimed invention because proposed modifications to a prior art reference that undermine its intended function cannot support a rejection under Section 103. As discussed above, if a venting port were used that interconnects the interior and exterior surfaces as set forth in Claim 40, the modified Orlosky device would not function so that “*as soon as* resin is seen filling the vent hole, the user knows that the casting cavity *is full*.” Thus, an obviousness rejection of Claim 40 based on Orlosky would be inappropriate as it would not allow this reference to operate as designed. *See In re Fritsch*, 972 F.2d 1260, 1265 n.12, 23 U.S.P.Q.2d 1780, 1783 n.12 (Fed. Cir. 1992) (“This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose.”) (citing *In re Gordon*, 733 F.2d 900, 902,

221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)); *Schneider (Europe) AG v. Scimed Life Sys., Inc.*, 852 F. Supp. 813 (D. Minn. 1994) (“Where obviousness is based upon a modification of a reference that destroys the intended purpose or function disclosed in a reference, there is no motivation for engaging in the modification.”) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)).

Because independent Claim 40 is allowable over Orlosky, its rejected dependent claims, Claims 41 and 42, are likewise allowable. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”). Therefore, applicant respectfully submits that Claims 40-42 should be allowed.

IV. Claim Rejections Under 35 U.S.C. § 103

The Examiner also rejected Claims 32-38 under 35 U.S.C. § 103 as being obvious over Cano *et al.*, U.S. Patent No. 5,611,969, in view of Orlosky. Here, the two references teach away from each other, undermining the viability of the Examiner’s obviousness rejection.

For Claim 32, the Examiner determined that “Cano et al discloses a strip used in the instant manner, the strip essentially lacking a recess channel formed on the inner surface thereof.” Office Action, p. 3, ¶ 4. To overcome this missing limitation, the Examiner stated that:

Orlosky discloses such a recess channel on the inside surface of a molding shell, the channel allowing for communication between a fill port and a vent port. It would have been obvious to one of ordinary skill in the art to modify the strip of Cano et al (once the edges have been joined) as taught in Orlosky to enable venting of air from the mold cavity.

Id. Applicant respectfully submits that Cano teaches away from using a recess channel and further submits that the Examiner's rejection inherently relies on hindsight reasoning.

The Federal Circuit outlined the analysis used to evaluate obviousness under Section 103 in *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). There, the Federal Circuit explained that:

Our [obviousness] analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... *Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.* In this case, the Board fell into the hindsight trap.

50 U.S.P.Q.2d at 1616-17 (emphasis added). Here, there is no "suggestion, teaching, or motivation" to combine the two references to render obvious the claimed invention.

To that end, Cano notes early in its "Detailed Description" that:

In accordance with the invention, the closure sleeve 14 is made from a heat shrinkable synthetic material and is heated to shrink it onto the molding shells 10A, 10B.

* * *

In the embodiment shown in FIGS. 1 through 5 the closure sleeve 14 is formed in situ by winding a strip 16 onto the edges 13A, 13B of the molding shells 10A, 10B.

The thickness of the strip 16 and consequently that of the closure sleeve 14 formed from it can be between 20 microns and 200 microns, for example.

Cano, col. 3, lines 41-53 (emphasis added). The reason for the thin thickness of the Cano strip—0.02 millimeters to 0.2 millimeters—is best illustrated in Figure 4, in which the strip has been shrunk onto the molds to secure them in place:

The heating operation which is then required to shrink the resulting closure sleeve 14 onto the molding shells 10A, 10B can use a plurality of nozzles 20, for example, as shown in FIG. 3, distributed circumferentially around the corresponding subassembly 17 and directed radially towards the subassembly 17 to blow a hot fluid (in practise air) onto it.

This shrinks the closure sleeve 14.

Id. at col. 4, lines 18-24.

In contrast to using this method of heat shrinking the *very* thin sleeve disclosed in Cano, Orlosky teaches using a much thicker gasket used to form a mold. In fact, Orlosky states that its “improvement” is the following attribute:

Referring now to the drawings and in particular to FIGS. 1, 2, 4 and 5, the improvement to the index markings used in connection with a plastic lens molding gasket will be described.

Orlosky, col. 3, lines 50-53. The patent disclosure further adds that:

The enlarged flanged edge 28 at the upper end of the gasket provides two important functions. First it acts to strengthen the outer portion of the gasket 10 without the need to add additional material to the entire wall of the gasket. Additionally, this enlarged annular edge 28 provides a convenient flat surface 30 having sufficient thickness to make the reading of the index numbers and lines 24 very easy.

Id. at col. 5, lines 16-23 (emphasis added). The thickness of the gasket in Orlosky is viewed as a positive attribute and, more importantly, integral to its functionality.

Accordingly, Cano and Orlosky teach different gasket designs, in which Cano specifies a very thin sleeve of 20 to 200 microns (0.02-0.2 millimeters) and Orlosky lauds the importance of a thicker gasket. As such, one of ordinary skill in the art prior to the present invention would not have been motivated to combine the teachings of Cano and

Orlosky because these two references teach away from each other—as opposed to providing the requisite “suggestion, teaching, or motivation” to combine them together.

One of ordinary skill in the art thus would not have been motivated to combine Cano and Orlosky without relying on impermissible hindsight reasoning. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *see also In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”).

Applicant also notes that in addition to the obviousness rejection being improper based on the references teaching away from each other, inconsistencies exist between the Examiner’s analysis and the teachings in the references. For example, the Examiner indicated that one skilled in the art would have been motivated to add the recess channel to “allow[] for communication between a fill port and a vent port.” The teaching of Orlosky, however, discloses that the communication between its ports occurs through the center of the mold cavity, such as when the gasket is horizontally disposed for filling:

This filling system, whereby the lens cavity is filled from side-to-side while the gasket is kept in a horizontal position, allows for much faster and bubble-free filling than was previously possible in the art.

Orlosky, col. 7, lines 36-40. The communication between the fill and vent ports of Orlosky is not via a channel running along the wall of the gasket, which is contrary to the Examiner’s basis for rejecting the claims.

Applicant respectfully submits that the Examiner’s analysis, therefore, presumes a function of the claimed recess channel that is not taught or suggested by Orlosky. This

further undermines that Cano and Orlosky render obvious Claim 32 and its dependent claims, Claims 33-38. Applicant respectfully submits that these claims are patentable over the prior art and requests allowance by the Examiner.

V. Non-Statutory Double Patenting Rejection

In paragraphs 5-7 of the Office Action, the Examiner set forth non-statutory double patenting rejections. Specifically, the Examiner rejected Claims 32-39 and 43 based on, *inter alia*, U.S. Patent Nos. 6,099,764 and 6,068,464. Although applicant disagrees with and traverses these rejections, applicant has filed herewith a terminal disclaimer citing both of these patents to expedite issuance of the above-identified application. This terminal disclaimer is believed to overcome the Examiner's non-statutory double-patenting rejection.

VI. New Claims 44-57

Applicant has also added new Claims 44-57, which sets forth patentable subject matter. New independent Claim 44 parallels Claims 1 and 7 and Claim 52 is similar to Claim 28. For the reasons that these independent claims were allowable over the prior art, applicant submits that Claims 44 and 56 are likewise allowable.

The new dependent claims, Claims 45-51 and 53-56, in many cases use the identical language as other claim limitations that the Examiner has already considered in this prosecution. As such, applicant also believes that the dependent claims are allowable, do not add any new matter, and satisfy the requirements of Section 112 of the Patent Act.

Last, applicant added new Claim 57, which substantially parallels Claim 40 as amended herein plus adds the limitation that the venting port and casting port form an acute angle. This combination of limitation is believed to be patentable over the prior art, as the arguments above and the previously allowed claims indicate.

Therefore, applicant respectfully submits that all of the new claims, Claims 44-57, are in a condition for allowance.

VII. Allowable Claims

The Examiner determined that Claims 1-25 and 27-31 are allowable. The Examiner also rejected Claim 43 based only on the non-statutory double-patenting rejection, which applicant has addressed as discussed above. Applicant, accordingly, has modified Claim 43 to be an independent claim to include all of the limitation of Claims 40 and 42 (as amended herein). Claim 43, as well as Claims 1-25 and 27-31, are thus in a condition for allowance.

CONCLUSION

Pursuant to the above amendments and remarks, allowance of the pending application is believed to be warranted. The Examiner is invited and encouraged to contact directly the undersigned if such contact may enhance the efficient prosecution of this application to issue.

Please charge \$395.00 to Deposit Account No. 13-2725 to cover the addition of thirteen added new claims in excess of twenty, four added new independent claims, \$55.00 for a terminal disclaimer, and \$55.00 for a one-month extension of time for a small entity. No additional fee is believed to be due; however, the Commissioner is

hereby authorized to charge any additional fees that may be required or credit any overpayment to this Deposit Account.

Respectfully Submitted,
Merchant & Gould

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Allan G. Altera
Reg. No. 40,274

Merchant & Gould, LLC
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
Telephone: 404-954-5100

Customer Number 23552